

a key module installed on a surface of the bulk body, operative to input parameters including measuring time, measuring interval, measuring times, and abnormal blood pressure threshold value;

a display, mounted on the surface of the bulk body, operative to display information; a controller, embedded in the bulk body;

an electronic manometer embedded in the bulk body and electrically connected to the controller, the electronic manometer being controlled by the controller to activate blood pressure measurement, the manometer being operative to transmit a measured blood pressure value to the controller;

a memory embedded in the bulk body and electrically connected to the controller, the memory being operative to store the parameters input by the key module; and a gas filling ring connected to the manometer via a tube, the gas filling ring being operative to apply a pressure on an arm or a wrist of a user to perform blood press.

(Emphases added).

Apparently the Examiner recognizes that at least two elements in Claim 1 of the application are not disclosed in Okada. In page 2 of the Office Action, the Examiner points out that Okada doesn't teach the key module installed on a surface of the bulk body, operative to input parameters including measuring time, interval, times and abnormal blood pressure threshold value and the memory being operative to store the parameters input by key module. (See claim 1 above with emphases added.) Nevertheless, the Examiner infers that the device according to Okada should have memory to store threshold values. The examiner cites Figs. 1 and 2 and the abstract of McEwen and renders that it is obvious to combine Okada and McEwen together to get the invention of claim 1. Applicant respectfully disagreed.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). Stated another way, the prior art as a whole must "suggest the desirability" of the combination. In re Beattie, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (internal quotation omitted); Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340 (Fed. Cir. 2000) ("Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter." (emphasis added)). The source of the teaching, suggestion, or

motivation may be "the nature of the problem," "the teachings of the pertinent references," or "the ordinary knowledge of those skilled in the art." In re Rouffet, 149 F.3d at 1355.

In regards to Okada and McEwen combination, Okada discloses a blood pressure measuring device having a wearable detector unit, a display unit, a diagnosing circuit and the display unit including warning display means. Meantime, McEwen discloses a pneumatic tourniquet used to stop the flow of blood into a limb by inflating an inflatable cuff around a patient's limb. McEwen discloses a tourniquet having automatic means for sensing cuff over-pressure against a selected pressure (for example, within about 6 mmHg of a pressure in the 200-400 mmHg range). An alarm will be triggered if the cuff pressure exceeds the safety range. (See Col. 2, lines 41-57 in McEwen). The purpose of McEwen's device is to stop the flow of blood in a patient's limb which automatically controls the cuff's pressure within a selected range. (See col. 4 lines 30 – 54). McEwen only measures and control the cuff pressure.

First, the nature of this application and Okada's invention is to provide a portable and easy to use blood pressure measurement device for an individual to usage. On the contrary, McEwen's device is used to stop blood flow during a surgery operation in a hospital. Okada's invention and McEwen's invention deal with two problems with different scopes and nature. Second, McEwen uses microprocessor to control and maintain the pressure of the cuff and a user can input selected parameters for McEwen's invention. However, McEwen doesn't teach or disclose these features to monitor blood pressure or heart beat from a patient. And Okada certainly doesn't teach using a key module to input parameters to his blood pressure measurement device, even if Okada has built-in memory to store some predetermined values. Nevertheless, a user can't input or modify these parameters as this application does, which is a major improvement over Okada.

Therefore, Applicant respectfully submits that it would not be obvious to a skilled person in the blood pressure measurement device field to combine Okada with McEwen. The standard

for obviousness is described in a recent case, In re Dance, 48 USPQ2d 1635 (CAFC 1998), as follows.

To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. *In re Raynes*, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Obviousness can not be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. In re Dance, 48 USPQ2d 1635, 1637 (CAFC 1998).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Also as stated in MPEP §2143.01:

The mere fact that references can be combined or modified do not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Focusing on the elements of "a key module and a memory module being operative to store the parameters input by the key module" in claims of this application, Besides the fact that the scopes and nature of Okada's invention is different from McEwen's, Okada doesn't teach or suggest using the input module for setting new parameters and a memory to store the input parameters. And McEwen, as a device used to stop blood flow, doesn't teach or suggest using a microprocessor to monitor a patient's blood pressure and to provide warnings if the patient's blood pressure is out of a safety range.

Therefore, Applicant respectfully submits that there is no teaching, suggestion or

motivation within the prior art to combine the prior art as the combination of features recited in Applicant's claims.

If the Examiner believes that a further telephonic interview will facilitate allowance of the claims, he is respectfully requested to contact the undersigned at (610) 446-5886. For the reasons stated above, Applicants respectfully assert that the pending claims are in condition for allowance. Reconsideration and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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